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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,690	06/06/2006	Burkhard Standke	287499US0PCT	3931

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EXAMINER
SCHIRO, RYAN RAYMOND

ART UNIT	PAPER NUMBER
1792	

NOTIFICATION DATE	DELIVERY MODE
12/18/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/581,690	STANDKE, BURKHARD	
	Examiner	Art Unit	
	RYAN SCHIRO	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06/06/2006, 02/15/2007, 07/13/2007 and 10/02/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20 are pending and presented for examination.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-9, 11 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Monkiewicz et al. (US 7026398) in view of Corpart et al. (US 5798415).

4. Monkiewicz teaches an air-drying silane coating composition containing an acrylic resin, and an aminoalkylsilane component, among other components (abstract). The relative humidity of the air during the coating and drying preferably 10-100% and the temperature is preferably in the range from 10-60 degrees Celsius, as required by claim 1 (col. 4, lines 34-43). The coating is applied using brushing, spraying, dip coating or rolling, as required by claim 9 (col. 9, lines 4-6). Very particularly suitable cocondensates that are included in the coating composition are those

obtained from at least one aminoalkylalkoxysilane and one fluoroalkylalkoxysilane, as required by claims 2-4 and 13 (col. 7, lines 24-26). Also, at least one acrylic is included in the composition, as required by claims 5 and 6 (col. 4, lines 8-13). The coating composition is particularly drawn to use as a scratch resistant, graffiti resistant and water resistant coating for a large variety of substrates, as required by claim 13 (col. 1, lines 15-60).

5. Monkiewicz does not teach that the composition is specifically to be used as a primer, that the composition is applied at a rate from 25-200 g/m^2 or that it has the specific hydrophobic and oleophobic properties as required by claims 1 and 7. Also, Monkeiwicz does not teach that the acrylate is fluoroalkyl modified or fluorofunctional, as required by claims 5 and 6. The amount of flourofunctional active substance is not taught, as required by claim 8.

6. Corpart teaches an oleophobic and hydrophobic treatment for building materials that contains an aqueous mixture of fluoro copolymers, as required by claim 7 (abstract). The treatment is drawn to anti-graffiti and anti-soiling treatment for building materials, as required by claims 1, 14 and 15 (col. 1, lines 4-12). The composition can include fluoroalkyl acrylates, as required by claims 5 and 6 (col. 8, lines 45-49). The composition may be applied in one or more layers by spraying, brushing, rolling, etc., so as to deposit the coating at a rate of 80-800 g/m^2, as required by claims 1, 9, 11 and 16-20 (col. 7, lines 33-40). A coating containing about 13% fluorine is achieved by example 1 of Corpart, as required by claim 8 (col. 8, lines 65-67). The hydrophobicity tests preformed on the examples of Corpart show in the data tables that the water uptake of the examples 1 and 2 are negligible compared to untreated substrates (col. 9, lines 30-35 and col. 10, lines 5-8). Also, the oleophobic tests of the examples 1 and 2 of Corpart show

that the penetration time of dodecane on the treated surface would take longer than 24 hours to penetrate into the substrate, as required by claim 1 (col. 9, lines 30-35 and col. 10, lines 5-8).

7. Since the difference in water uptake between an untreated substrate and treated substrate according to Corpart are so substantially different, it is an inherent property of the coating composition of Corpart that the hydrophobic properties would allow for a drop of water to evaporate before penetrating into the substrate, as required by claim 1. Also, Corpart teaches that the coating composition can be applied in one or more layers. A first layer of the composition would fit the standard definition of a primer, which is an under coating that is applied as to prepare a surface for another overcoating. Therefore, the composition of Corpart can be considered both an overcoating composition and a primer composition, as required by claims 1-13. The overcoating of the composition of Corpart is also considered an impregnating composition. The art does not recognize any distinction between coating and impregnating. *In re Marra et al.,* 141 USPQ 221.

8. It would have been obvious to a person ordinarily skilled in the art at the time of the invention to combine the teachings of flouroalkyl acrylates, a multiple coating process and obtaining the specific hydrophobic and oleophobic properties of Corpart with the air drying and fluoroalkyl/amonoalkyl funcitional silane composition taught by Monkiewicz. One would have been motivated to make this combination because the teachings of Corpart is drawn to improving the ability of the composition to be coated on a very wide variety of substrates, including building materials, paper, textiles, leather, etc., and the teachings of Monkiewicz are drawn to providing good adhesion to a variety of substrates.

9. Neither Monkeiwicz nor Corpart teach that the coating process is performed using an airless or HVLP process, as required by claim 12. Also, the previously mentioned teachings do not specifically teach a four hour or more drying time between the application of the first, or primer, coating and a second coating, as required by claim 10.

10. Claims 10 and 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Monkiewicz et al. in view of Corpart et al. (US 5798415) further in view of Bartkowiak et al. (US 2003/0203117).

11. Bartkowiak teaches a process for impregnating porous mineral substrates by a spraying technique (abstract). Specifically, Batowiak is drawn to a coating comprised of liquid fluorinated polymers and silicone containing impregnating agents to be used as oleophobic agents (0033 and 0034). Use of an HVLP or LVLP technique permits uniform application of the impregnating agents on highly porous substrates (0039). The amount of impregnating agent preferably applied per spray pass is 1-200 g/m^2 (0037). Multi-step processes consisting of applying multiple layers of the coating allowing around 4 hours of drying time between applications is also disclosed in examples of Bartkowiak (0100-0101).

12. It would have been obvious to a person ordinarily skilled in the art at the time of the invention to combine the teachings of a specific flourofunctional containing coating composition as taught by Monkiewicz in view of Corpart with the time requirements and spraying techniques as taught by Bartkowiak. One would have been motivated to make this combination because Bartkowiak is drawn to a very similar composition used for the same purpose of providing a hydrophobic and oleophobic coating and the spraying techniques taught provide the added

improvements of precise local application, the ability to use less solvent in the composition, less loss of product and avoids the usage of complicated emulsifying technology (0039).

Conclusion

Claims 1-20 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Schiro whose telephone number is 571-270-5345. The examiner can normally be reached on Monday-Friday from 8:30 AM to 6 PM.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached at 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan Schiro
Art unit 1792

/Michael Barr/

Supervisory Patent Examiner, Art Unit 1792